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EXAMINER	
DICUS, TAMRA	
ART UNIT	PAPER NUMBER
1794	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/749,087	BERDAN ET AL.	
	Examiner	Art Unit	
	TAMRA L. DICUS	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07/01/08*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 4-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 4-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The RCE is acknowledged.

The drawings, previous claim objections, prior 112 first and second paragraph over claim 1 (in part), and claims 4-19, prior 102b and 103s over Heller, and the 102b over S.B. Schumacher are withdrawn.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims1-28 of U.S. Patent No. 6,669,2645 to Tilton et al. in view of US 3,096,879 to S.P. Schumacher.

Tilton instantly claims the same as what is patented but including process limitations to folding and shaping the patented article. It would have been obvious to shape the claims of Tilton to contour to any article, such as the article of Schumacher, teaching fold points and tucking flaps in to secure and contain an inner article. See Schumacher, entire patent, especially cols. 3-4.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, and 4-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites an edge portion that is formed of a compressed first material (already of a first density in line 3, of claim 1). It is not clear what or how to have the same material having a first and a second density, which appears to be contradictory. It is not clear if there is a second material having a corresponding second density, or a mixture of some sort between said first

and second density. The specification lacks guidance to these issues and thus it is not understandable because it is not clear.

Re claims 7 and 9, "is formed with" makes it confusing as to if it should be "comprises" (as is normal) or "further comprising" (additional).

Claim 10 recites "said flange is positioned flush against said main body and establishes a side surface"; it is not clear how the flange establishes a surface.

Claim 18 appears not to further limit claim 10 as the edges of the flanges are already of compressed fibers. It is not clear what is intended.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 4-19 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tilton et al. (US 6669265 B2).

Tilton teaches a decorative acoustic panel (Figs, 3, 4, and 7) wherein decorative facings, and reinforced materials (22 and 12, see col. 5, lines 5-col. 6, lines 40) surround main body pad 12 of fibrous bicompoent fibers (4:55-68-claim 4), having higher density on the edge peripheral parts (see 16, Fig. 3-4 and flange in Fig. 7, see 7:5-10), with lower density in other main body portions (see Figs. 3-4).

While it is inherent and shown a "fold point", see the valley or dip of Fig. 7 to extend into 30 (claims 1 and 10), Tilton doesn't explicitly teach a fold point however, shows that the flange is shaped to fit around a vehicle. Thus it would have been obvious to one having ordinary skill in the art to have folded or translocated edges to contour to the shape of an automobile as taught by Tilton. Further to the rotating and applications prior to forming compressed regions and heat applications, folding actions (claims 7-10 and 14-15, and 17), these are product limitations in a process claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698. Both Applicant's and prior art reference's product are the same.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, and 5-19 are rejected under 35 U.S.C. 103(a) as obvious over S.P. Schumacher (US 3,096,879).

Schumacher teaches a variety of synthetic fibers (first thermoplastic material) included in the body 2 and having an edge flap 8, 9 shown folded and tucked in the body of 2 in Fig. 3 (and therefore rotated and compressed- as a means of additional protection against shock) of compressed fibers (see 3:55-60, 4:1-3, 4:65-75). This is seen as functioning as an acoustic panel since the same material and structure is taught, see MPEP 2111.02. Without such reliance, however, a preamble is generally not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention. Consequently, "preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant." In *Poly-America LP v. GSE Lining Tech. Inc.*, 383 F.3d 1303, 1310, 72 USPQ2d 1685, 1689 (Fed. Cir. 2004). The

inner region that is compressed is inside the innermost of the tucked part, the outer region outermost side (while not identified, see the regions laterally extending to the right of 8 and 9 in Fig. 3). Because the body and edge are of the same fibrous material, it extends throughout the edge. See also 3:50-60. The fibers are compressed to absorb shock and can be compressed without the loss of loft. Crimped and, curled, fibers also may be used give greater loft than the same amount of straight fibers, which means an inherent lesser density is provided. Therefore this implies use of the crimped or curled have a lesser density (at the fold or compressed regions) than the straight fibers (not around the compressed part - the regional area furthest away from the point where the flap folds). See 4:1-25.

Alternatively, if objective evidence proving that the claimed effective density is not inherent in Schumacher, then it would have be obvious to have effected the density because Schumacher teaches compressed or straight fibers effect the loft and resultant density and thus choosing the type of fiber effects the density, and thus the density is a result-effective variable as it effects the loft of the overall package. It is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980). See also MPEP § 2144.05 II (B). Moreover, dependent upon the variety

of thermoplastics chose for the synthetic fibers, the inherent density of the polymer itself may be greater or lesser dependent upon the obvious choice of material to yield the desired density.

A backing sheet 4 of paper and a facing fibrous sheet are secured on the body 2 and is equivalent to a decorative veil and a second material. There are several flanges and edges in a non-linear shape shown in Fig. 3.

Further to claims 1, 4-5, and 7-19, product by process limitations such as formed by rotating, as recited are given little weight in a product claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698. Both Applicant's and prior art reference's product are the same. Claims 1, 5-19 are met.

Further to designs on the edge (claim 13), it would have been obvious to have decorated it for instruction or aesthetic purposes. Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Having established that this knowledge was in the art,

the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Hoeschele*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969).

Claims 1, and 5-19 are rejected under 35 U.S.C. 103(a) as obvious over S.P. Schumacher (US 3,096,879) in view of US 4,131,664 to Flowers et al.

Should the 103 rejection above not be obvious alone, the following rejection is submitted below:

S.P. Schumacher teaches the invention above.

S.P. Schumacher, while obvious to do so, does not explicitly state the density requirement.

Flowers teaches an acoustic panel wherein fibrous layers are well known to vary density by using different fibers, including polymeric types, therein or by well known air-laying techniques to achieve the desired thickness and density, good acoustical, thermal insulating, and mechanical properties (see at least col. 5, lines 20-68, col. 6, lines 1-68).

It would have been obvious to one having ordinary skill in the art to have modified the fibers of S.P. Schumacher to include different types or different techniques to arrive at various densities as desired as this is a well known concept as told by Flowers used in acoustical panels to affect thickness, ease of

processing, good acoustical, thermal insulating, and mechanical properties as cited above.

Claim 4 is rejected under 35 U.S.C. 103(a) as obvious over S.P. Schumacher (US 3,096,879) in view of Chenoweth (US 4946738).

Schumacher is applied above.

Schumacher does not teach using bicomponent fibers as per claim 4, while as said above teaching any synthetic fiber may be used (see again 2:15-30).

Chenoweth teaches a nonwoven material comprising a matrix consisting of glass fibers, solid or hollow homogeneous synthetic fibers, such as polyester, nylon and second, bi-component synthetic fibers which have been intimately combined with a thermosetting resin into a homogeneous mixture. This mixture is dispersed to form a blanket and melted to be formed into complexly curved and shaped configurations. See 1:1-30, 3:1-10, 4:30-68, Abstract.

It would have been obvious to one having ordinary skill in the art to have modified the Schumacher to include bicomponent polyester fibers as claimed because Chenoweth teaches the fibers are used for reinforcement purposes and for insulating characteristics in curved and shaped configurations and panels as cited above. To the application of heat and bonding process steps, these are in a product claim, given little weight. See product by process rationale above.

Claims 1, and 5-19 are rejected under 35 U.S.C. 103(a) as obvious over S.P. Schumacher (US 3,096,879) in view of Re. 36,323 to Thompson et al.

Schumacher is applied above.

Schumacher does not teach using a mixture of first and second density as claimed (should both first and second density and corresponding materials apply) (claims 1 and 5-19).

Thompson teaches an acoustic panel wherein fibrous materials such as crimped, polymeric (having a denier of 2 or less), and staple fine fibers are air laid in amounts that requirements for density are met. Thereby teaching the density is a result-effective variable, dependent upon what time of fiber material and process is employed. The fibrous panel may also be laminated to a scrim or foil and functions as a decorative trim panel. The panel has adhesive 40, Fig. 7, as reinforcing edge material. See at least col. 4, lines 49-68, col. 5, and col. 6.

It would have been obvious to one having ordinary skill in the art to have modified any portion of the edge or main body of the fibrous panel of Schumacher to use, include, or substitute the fibers or reinforcement of Thompson because they affect the density of the fibrous layer, used in acoustic panels as cited above.

Further to the rotating and applications prior to forming compressed regions and heat applications, folding actions (claims 7-10 and 14-15, and 17), these are product limitations in a process claim. See rationale above.

Claim 4 is rejected under 35 U.S.C. 103(a) as obvious over S.P. Schumacher (US 3,096,879) in view of Re. 36,323 to Thompson et al., as applied to claim 1, and further in view of Chenoweth (US 4946738).

Schumacher is applied above.

Schumacher does not teach using bicomponent fibers as per claim 4, while as said above teaching any synthetic fiber may be used (see again 2:15-30).

Chenoweth teaches a nonwoven material comprising a matrix consisting of glass fibers, solid or hollow homogeneous synthetic fibers, such as polyester, nylon and second, bi-component synthetic fibers which have been intimately combined with a thermosetting resin into a homogeneous mixture. This mixture is dispersed to form a blanket and melted to be formed into complexly curved and shaped configurations. See 1:1-30, 3:1-10, 4:30-68, Abstract.

It would have been obvious to one having ordinary skill in the art to have modified the combination to include bicomponent polyester fibers as claimed because Chenoweth teaches the fibers are used for reinforcement purposes and for insulating characteristics in curved and shaped configurations and panels

as cited above. To the application of heat and bonding process steps, these are in a product claim, given little weight. See product by process rationale above.

Claims 6-7, 9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable S.P. Schumacher (US 3,096,879) in view of Re. 36,323 to Thompson et al., as applied to claims 1 and 10, and further in view of US Hoffman, Jr. (US 3835604 A) or alternatively in view of US 6,321,871 to Russell.

The features of the combination are relied upon above.

The combination does not teach decoration material on top or edges as per instant claims 6-7, 9, and 13.

Hoffman, Jr. teaches a similar folded facing and insulation panel wherein a principal objective of his invention is to provide building insulation of the general kind referred to with a facing sheet having a decorative pattern such as indicia, so that the installed appearance of the insulation is aesthetic or attractive (1:40-55, 4:1-15, Fig. 1 and Fig. 1a and associated text).

Russell teaches acoustic panels and the like having decorative photographic images generated by a computer on a membrane (veil) (see at least col. 2, lines 9-68) to create a cost effective high quality cosmetic change in the appearance of an acoustic panel.

It would have been obvious to one having ordinary skill in the art to have modified the panel of the combination to include decoration as claimed for

aesthetic or attractive appearance as taught by Hoffman, Jr. and Russell cited above. While the decoration is not shown on the edges, it would have been obvious to extend it throughout the entire body to further make the entire panel attractive, especially by the aid of a computer printer as described by Russell.

Response to arguments

The arguments are moot in view of the new ground of rejection. To arguments over Schumacher alone, compressing and rotating as argued by applicant are not convincing because they are process limitations in a product claim, where Schumacher shows the final product flat or in the end product as a tucked panel.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art Unit 1794

Tamra L. Dicus /TLD/
Examiner
Art Unit 1794

March 25, 2009